



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,292	12/02/2003	Shinichi Tsuzaki	JCLA12308	5325

23900 7590 09/15/2006

J C PATENTS, INC.
4 VENTURE, SUITE 250
IRVINE, CA 92618

EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT PAPER NUMBER

1661

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,292

Applicant(s)

TSUZAKI ET AL.

Examiner

S. B. McCormick-Ewoldt

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>July 6, 2006</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1661

DETAILED ACTION

The amendment of August 8, 2006 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of Application

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

Claims Pending

Applicant has cancelled claims 3-10. Claims 1-2 and 11 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shen *et al.* (US 6,013,771) in view of Lee (US 6,413,557) in view of Obata *et al.* (US 6,444,239).

Shen *et al.* (US 6,013,771) discloses producing an isoflavone rich protein material from vegetable matter (i.e. soybean materials), which is extracted with an aqueous extract and then is separated from insoluble material to produce an extract containing isoflavones and protein (column 2, lines 45-52; column 4, lines 45-47). The vegetable material used is obtained from soybean materials (column 3, lines 30-33). Shen also discloses that separation of precipitated protein material from the extract at cool or cold temperatures (i.e. below 90°F) unexpectedly significantly increases the amount of isoflavones trapped in the separated protein material

Art Unit: 1661

(column 3, lines 16-26). The pH of the aqueous extract is preferably about pH 6.0 to about pH 10 (column 4, lines 7-8).

Shen does not disclose wherein lipid content are disclosed.

Lee (US 6,413,557) discloses soybean hypocotyls have high a concentration of isoflavones (column 5, lines 6-9). The hypocotyls axis contains lipids (column 4, lines 63-65).

Obata *et al.* (US 6,444,239) disclose that isoflavone precipitate can be freeze-dried (see Example 2).

One of ordinary skill in the art would have been motivated to use isoflavones obtained from soybean hypocotyls because of the high concentration of isoflavones in soybean hypocotyls, as disclosed in Lee, and to separate them for a protein rich soluble composition. It was clear from the Shen reference that isoflavone rich protein material from soybean material can be extracted with an aqueous extract, and then separated from insoluble material to produce an extract containing isoflavones and protein. Shen also discloses the separation of precipitated protein material from the extract at cool or cold temperatures (i.e. below 90°F) unexpectedly significantly increases the amount of isoflavones and also discloses the pH of the aqueous extract is about pH 6.0 to about pH 10. It was further clear from the Lee reference that soybean hypocotyls have a high concentration of isoflavones. It was further clear from the Obata reference that isoflavone precipitate can be freeze-dried. Although none of the references disclose the amounts of isoflavones or the protein content or the lipid content it would be deemed merely a matter of judicial selection and routine optimization, which is well within the purview of the skilled artisan.

Therefore, one of ordinary skill in the art would have had a reasonable expectation to use an aqueous extract in which to extract isoflavones from soybean hypocotyls because of their high concentration of isoflavones.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

Summary

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme



CHRISTOPHER R. TATE
PRIMARY EXAMINER